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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



In re Patent Application of

Maertens et al

Atty. Ref.: 2752-31

Serial No. 08/836,075

Group: 1631

Filed: May 9, 2001

Examiner: Zeman

For: NEW SEQUENCES OF HEPATITIS C VIRUS GENOTYPES AND THEIR USE
AS PROPHYLACTIC, THERAPEUTIC AND DIAGNOSTIC AGENTS

#34
Plunkett
11/16/03

* * * * *

December 19, 2002

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

RESPONSE

Responsive to the Official Action dated November 19, 2002, reconsideration and withdrawal of the restriction requirement, and allowance of all the pending claims, are requested.

Specifically, the applicants note that the subject matter of the present claims was allowed and issued as U.S. Patent No. 6,180,768, which the applicants withdrew from issue for consideration of further art. See, the attached copy of 1243 OG 1040, February 27, 2001, which confirms that "all reference to Patent No. 6,180,768... should be deleted since no patent was granted."

Also attached, for the Examiner's convenience, is a copy of the claims issued in U.S. Patent No. 6,180,768, wherein the undersigned has included bracketing to

specifically indicate subject matter deleted from the allowed claims, as compared to the presently pending claims. The Examiner will appreciate from a review of the attached marked-up copy of the claims issued in the U.S. Patent No. 6,180,768, that the present Examiner has allowed the subject matter of the present claims. Accordingly, there is no additional search burden on the Examiner in allowing the pending claims. Moreover, the Examiner has already searched, among other things, Class 536, Subclass 23.1 and Class 530, Subclass 300, in allowing the claims of U.S. Patent No. 6,180,768. See, the attached first page of U.S. Patent No. 6,180,768. Accordingly, while the Examiner has indicated that the subject matter of the indicated Groups is distinct, presumably based on separate classification of the same, the Examiner has already searched all the claimed subject matter, as well as other subject matter and examination of the pending claims will not be an undue burden on the Examiner.

The Examiner has before her all of the art from the search which was completed by the Patent Office with regard the broader allowed claims of U.S. Patent No. 6,180,768. Accordingly, the potential additional search burden described by the Examiner on page 2 of the Office Action dated November 19, 2002 (Paper No. 38) is not existent in the present case. The Examiner's comments with regard to "processing" on page 2 of Paper No. 38 is not understood. Clarification is requested in the event the Examiner continues to require restriction. In any event, the Examiner has previously found the claimed subject matter to define a single patentable invention and to not place an undue burden on the Examiner in searching. Withdrawal of the restriction requirement is requested.

With regard to the additional restriction requirement relating to single sequences, the applicants again note that the Examiner has allowed the subject matter of the present claims in U.S. Patent No. 6,180,768. The Examiner's basis for requiring the restriction requirement (i.e., "In view of Office Resources, the search in examination of more than one sequence would pose an undue burden upon the Office,..."), is not applicable as a basis for requiring election of a single sequence in the present case. The applicants assume the Examiner is not proposing to complete a new search, ignoring the previous searches which led to the allowance of the presently claimed subject matter in U.S. Patent No. 6,180,768.

The Examiner is urged to appreciate that a significant amount of resources of the Patent Office as well as the applicants have been already spent in searching and examining the presently claimed invention. The Examiner is urged to withdraw the restriction requirement and forward a Notice of Allowance based on the already developed extensive file history.

An Alternate Rule 181 Petition is filed herewith to be considered in the event the Examiner refuses to withdraw the restriction requirement. Consideration of the same is requested in the event the Examiner maintains the restriction requirement.

For the purposes of being responsive only, the applicants elect, with traverse, the subject matter of the Examiner's Group I and SEQ ID NO:43.

Alternatively, in the event the Examiner is willing to examine less than all of the previously allowed claims but more than a single sequence, the applicants elect SEQ ID

NOs:43, 45, 47, 91, 93 and 95. As a further alternative, the applicants elect, with traverse, the subject matter of SEQ ID NOs:43, 45 and 47 for examination.

For the reasons noted above, the applicants submit that the subject matter of the presently claimed invention has already been allowed by the present Examiner, as evidenced by U.S. Patent No. 6,180,768. The restriction requirement of November 19, 2002, should therefore be withdrawn and the present claims allowed.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By:



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